

Docket 2000FR302
Serial No. 09/778,353
Group 1821

REMARKS

Claim 12 stands rejected under 37 CFR 1.75. Applicants have canceled claim 12.

Claims 13-16 stand rejected under 35 USC § 101 for reciting a use without setting forth the process steps. Applicants have canceled claims 13-14 and amended claim 15-16 and respectfully request that this objection be withdrawn and the claims allowed.

Claims 13-16 stand rejected under 35 USC § 112 as being indefinite. Applicants have canceled claims 13-14 and amended claims 15-16 to overcome this objection and respectfully request that this objection be withdrawn and the claims allowed.

Applicants have added a new claim 18, which is supported by the specification page 6 lines 19-28. Applicants respectfully request allowance of this claim.

Applicants have amended claims 1 and 2, based on an error discovered in the foreign prosecution. In claim 1, n cannot have the value 3, if at least one of the ortho or para positions is substituted by an hydrogen since the -CH(OH)R group(s) is (are) also attached at ortho or para positions. Applicants have amended claim 1 to overcome this problem. On the other hand, the different examples show the use of phenols of formula (II) which have an H in position meta when the substituents R2 and R4 are not defined as possibly being an H. Claim 2 has been amended to overcome this problem, and is necessary in light of the amendment to claim 1. Applicants have attached the correspondence from the European Patent Office with this Amendment to support these changes in this late stage of prosecution. Applicants respectfully request that the office accepts these changes to Claims 1 and 2 in order to put these claims in condition for allowance.

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As the total number of claims does not exceed the number of claims originally paid for, no fee is believed due. However if an additional fee is required, the Commissioner is hereby authorized to credit any overpayment or charge any fee deficiency to Deposit Account No. 03-2060.

Entry of the above amendment is respectfully requested.

Respectfully submitted,



Scott E. Hanf, Registration No. 38,906

Attachment: EPO correspondence of September 10, 2003 (4 pages)

(CUSTOMER NUMBER 25,255)

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(Substantive examination)

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(Formalities and other matters)



Application No: 01 810 115.4-1211	Ref: 2000FR302	Date: 10.09.2003
Applicant: Clariant (France)		

Communication pursuant to Article 96(2) EPC

The examiner of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 4 months

from the notification of this communication, this period being computed in accordance with Rules 78(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).



WRIGHT M.W.
Primary Examiner
for the Examining Division

Enclosure(s): 3 pages/Reasons (Form 2806)

Registered Letter
05-09-2003 07.02.05

Boilerplate/Protocol (Anlage)		Communication/Minutes (Annex)		Notification/Procès-verbal (Annex)	
Date:	Document No.:	Date:	Sheet	1	Annex No.:
10.09.2003				1	Application No.: 01 610 115 2 Demand No.:

The examination is being carried out on the following application documents:

Text for the Contracting States:

AT BE CH CY DE DK ES FI FR GB GR IE IT LU MC NL PT SE TR LI

Description, pages:

1-18 as originally filed

Claims, No.:

1-15 as originally filed

Drawings, sheets:

1/1 as originally filed

(1) The following document (D) is referred to in this communication; the numbering will be adhered to in the rest of the procedure:

D1: WO 97/11119.

(2) Although claims 1-15, insofar as they are clear, meet the requirements of Article 52(1) EPC with respect to the available prior art, amendment is required to overcome the objections below.

(a) The application does not meet the requirements of Article 84 EPC, because claims 1-15 are not clear.

(i) In claim 1 n cannot have the value 3 if at least one of the ortho or para positions is substituted by hydrogen since the -CH(OH)R group(s) is(are) also attached at ortho or para positions.

(ii) The term "functional group such as" used in claim 1 is vague and unclear and

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Beschluß/Protokoll (Anlage)	Communication/Minutes (Annex)	Notification/Procès-verbal (Annexe)
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leaves the reader in doubt as to the meaning of the technical features to which it refers, thereby rendering the definition of the subject-matter of said claim unclear.

(iii) Claim 2 is formally unclear in that it lacks a reference to claim 1. Furthermore, claim 2 is unclear in that:

(1) the definitions of R₁, R₅ in formula (II) and of R in formula (III) do not entirely correspond to those for X or R, respectively, in formula (I) of claim 1.

(2) since the process according to claim 2 involves the replacement of ortho- and/or para-hydrogen atom(s) by the RCH(OH)-group(s) and since the product still has at least one ortho or para position substituted by hydrogen, it appears to be an essential feature of the process according to claim 2 that at least two of the ortho or para positions of the compound of formula (II) are substituted by hydrogen.

(3) whereas the ortho and para substituents R₁, R₃ and R₅ can be a hydrogen atom, the meta-substituents R₂ and R₄ are not so defined that they can be hydrogen; this is at variance with the examples, in all of which meta-positions are occupied by hydrogen atoms.

(iv) Claims 12-15 are formulated as use claims for compounds according to claims 1-11 whereas only claim 1 is a claim for compounds, claims 2-11 relating to processes.

(b) To meet the requirements of Rule 27(1)(b) EPC, the document D1 should be identified in the description and the relevant background art disclosed therein should be briefly discussed.

3). Formula 1 on page 2 of the description requires amendment: hydrogen atoms of the methoxy groups are missing.

4). Your attention is drawn to the fact that the application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC). In order to facilitate the examination



Beschluß/Protokoll (Anlage)	Communication/Minutes (Annex)	Notifikation/Prozeß-verbal (Annex)
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of the conformity of the amended application with the requirements of Article 123(2) EPC, you are requested to clearly identify the amendments carried out, irrespective of whether they concern amendments by addition, replacement or deletion, and to indicate the passages of the application as filed on which these amendments are based.

If you regard it as appropriate these indications could be submitted in handwritten form on a copy of the relevant parts of the application as filed.

Any information you may wish to submit concerning the subject-matter of the invention, for example further details of its advantages or of the problem it solves, and for which there is no basis in the application as filed, should be confined to the letter of reply and not be incorporated into the application (Article 123(2) EPC and the Guidelines, C-VI, 5.7 et seq.).